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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,260

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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

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1616

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,260	<b>Applicant(s)</b> TSUCHIKAWA ET AL.	
	<b>Examiner</b> DANIELLE SULLIVAN	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/10/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/501,401 in view of Yoneyama et al. (US 5,362,482). Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application does not contain 39.9 to 89.9% ester oil.

The instant application claims a composition comprising an ester compound (0.1-10%, preferably 0.4-2%); ester oil (39.9-89.9%, preferably 57.1-74.8%) and ultraviolet protective powder (10-50%, preferably 24.8-39.9%). The composition may further comprise hydrogenated lecithins.

Copending application '401 discloses a composition comprising ester compound (0.1-30), ester oil (0.5-20%) and a surfactant (0.1-40%). Surfactants include hydrogenated lecithin's [0035]. Example containing ultraviolet protective powders such as titanium dioxide (12%) are disclosed (Example 12; [0049]).

Copending application '401 does not teach that the range of the ester oil is 39.9-89.9%, preferably 57.1-74.8% or the preferred range of ultraviolet protective powder is 24.8-39.9%. It is for this reason that Yoneyama et al. is joined.

Yoneyama et al. teaches cosmetic compositions containing an oil component and a powder (abstract). The composition comprises 5% to 85% by weight of oil (column 3, lines 47-50). The oils may be selected from glycerol tri-2-ethylhexanoate

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and pentaerythritol tetra-2-ethylhexanoate (ester oils) (column 5, lines 41-60). The powder comprises 5-50% by weight as conventionally used in cosmetic compositions and include titanium oxide and zinc oxide (column 6, lines 21-44).

One would have been motivated to manipulate ranges during routine experimentation to discover the optimum or workable range since Yoneyama et al. provides the general ranges. Therefore, one would have been motivated to use the appropriate amount of ester oil and ultraviolet protective powder necessary to achieve the cosmetic product disclosed in the present claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "the storage elastic modulus" in reference to claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the area enclosed by the shear rate and shear stress" in reference to claim 1. There is insufficient antecedent basis for this limitation in

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the claim. For, the purpose of examination the claims will be treated as pertaining to an intended use.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama et al. (US 5,362,482) in view of Suzuki (US 6,759,052).

### **Applicant's Invention**

Applicant claims a preparation comprising 0.1-10% by weight an ester compound, 39.9-89.9% by weight of an ester oil and 10 to 50% by weight of an ultraviolet protective powder. Claim 2 specifies the preparation comprises the ester compound 0.4-2%, ester oil 57.1-74.8% ultraviolet protective powder 24.8-39.9%. Claims 3 and 4 specify the ester compound is glycerin behenate eicosanedioate (Nomcort HK-G). Claim 5 specifies the ester oil has a viscosity of 4-100 mPa\*s at 20°C. Claim 6 and 7 further limits to the ester compound being selected from neopentyl glycol dicaprate, glyceryl tri-2-ethylhexanoate and pentaerythritol tetra-2-ethylhexanoate. Claim 8 specifies the u/v protective powder is selected from titanium dioxide, iron-containing titanium dioxide and zinc oxide. Claim 14 specifies that the preparation is a cosmetic. Claim 15 further limits the cosmetic to being selected from lotions, creams, ointments, foundations, lipsticks,

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mascaras, eyeshadows, eyebrows, nail enamels and cheek colors. Claim 16 specifically lists the preparation as comprising 0.1-10% ester compound, 39.9-89.9% ester oil and 10-50% ultraviolet protective powder, wherein the limitations of claims 7 and 8 are added.

**Determination of the scope and the content of the prior art**

**(MPEP 2141.01)**

Yoneyama et al. teaches cosmetic compositions containing an oil component and hydrophobically treated powder (abstract). The composition comprises 5% to 85% by weight of oil (column 3, lines 47-50). The oils may be selected from glycerol tri-2-ethylhexanoate and pentaerythritol tetra-2-ethylhexanoate (column 5, lines 41-60). The powder comprises 5-50% by weight as conventionally used in cosmetic compositions and include titanium oxide and zinc oxide (column 6, lines 21-44).

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

Yoneyama et al. does not teach the specific ester compound. It is for this reason that Suzuki is added.

Suzuki teaches cosmetic compositions comprising ester compounds as an emulsifier, glycerin fatty acid surfactant (column 6, lines 34-39). The cosmetic compositions comprising Nomcort HK-G (3%) and isotridecyl isononate (0.2%) in the form of a cream (Example 46). The amount of ester compound can range from 0.1-10% and provides a light feel, stability and fluidity when applied on the skin (column 7, lines 22-25).

**Finding of prima facie obviousness**

**Rationale and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Yoneyama and Suzuki to use the ester compound in the cosmetic compositions. One would have been motivated to include glycerin fatty acid surfactants such as glyceryl behenate eicosanedioate because Suzuki teaches that it is used in cosmetic compositions to provide a light feel, stability and fluidity to cosmetic compositions.

Claims 9-11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama et al. (US 5,362,482) in view of Suzuki (US 6,759,052) and in further view of Miyoshi et al. (US 5,968,531).

**Applicant's Invention**

Applicant claims a preparation as discussed in above 103(a) rejection. Claims 9 and 17 further adds lecithin to the composition. Claim 10 specifies the ratio of lecithin to the total composition is 0.0001:1 to 0.05:1. Claim 11 specifies that the lecithin is hydrogenated.

**Determination of the scope and the content of the prior art**

**(MPEP 2141.01)**

Yoneyama et al. and Suzuki teach the composition as discussed in above 103(a) rejection. Suzuki also teaches that the cosmetic composition comprise powders



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including coated mica. To improve dispersability or adhesion, the powders can be surface treated by metallic soaps.

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

Yoneyama et al. and Suzuki do not teach that lecithin is added. It is for this reason that Miyoshi et al. is joined.

Miyoshi et al. teaches that hydrogenated lecithin is a surface treating composition used, to impart desired characteristics to composite powders in conjunction with metallic soap (column 3, line 62-67). The agents aid in a desired aesthetic feel, pressability and improved transparency on the skin (column 4, lines 4-7). An example of a compressed powder foundation comprising 7% hydrogenated lecithin treated mica is disclosed (Example 3).

**Finding of prima facie obviousness**

**Rationale and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Yoneyama, Suzuki and Miyoshi et al. to further include hydrogenated lecithin in the cosmetic compositions. One would have been motivated to include lecithin because Miyoshi teaches that adding hydrogenated lecithin to composite powders improve their aesthetic feel and transparency on the skin.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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—

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